

REMARKS

In response to the Office Action dated January 13, 2005, claims 1, 4, 7, 10, 13, 19, 23, 27, and 30 have been amended. Claims 1-32 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action objected to claim 1 due to minor informalities.

The Applicants have amended claim 1 as suggested by the Examiner to overcome this objection.

The Office Action rejected claims 1-3, 6, and 19-22 under 35 U.S.C. § 103(a) as being unpatentable over Wang et al. (U.S. Patent No. 6,314,454) in view of Patterson (U.S. Patent No. 6,751,670). Also, the Office Action rejected claims 7-9, 12-16, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Wang et al. in view of Patterson and Conmy et al. (U.S. Patent No. 6,101,480). Next, the Office Action rejected claims 4-5, 23-26, and 30-32 under 35 U.S.C. § 103(a) as being unpatentable over Wang et al. in view of Patterson and Mitsuya (JP-411312068A). Last, the Office Action rejected claims 10-11, 17, and 27-29 under 35 U.S.C. § 103(a) as being unpatentable over Wang et al., Patterson and Conmy et al. (U.S. Patent No. 6,101,480), in view of Mitsuya (JP-411312068A).

The Applicant respectfully traverses these rejections based on the amendments to the claims and the arguments below.

The Applicants' independent claims now include receiving a history record and a validation/audit of the requested type of delivery upon receipt/consumption of the e-media in the form of a biometric signature to indicate receipt/consumption of the e-media by the client/receiving party to allow the client/receiving party sender/user to make future e-media delivery decisions. The validation/audit of the requested type of delivery is unattended by the client/receiving party and the sender/user the history record is sent with regular status updates on availability times of the client/receiving party to receive new e-media based on the events of the history record.

In contrast, Wang et al. in combination with Patterson, Conmy and Mitsuya do **not** disclose all of the Applicant's elements of the currently amended claims. Specifically, **none** of cited references, in combination or alone, disclose the Applicant's sending a validation/audit the form of a biometric signature, having a delivery that is unattended by the client/receiving party, and sending the history record with regular status updates on

availability times of the client/receiving party to receive new e-media based on the events of the history record.

Further, even though the combination of the numerous cited references does not produce all of the elements of the claimed invention, these references and any new references should not be considered together since there is no motivation to combine the cited references. It is well-settled law that there must be a basis in the references for combining or modifying the references. C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 48 USPQ 2d 1225, (Fed. Cir. 1998). Namely, the Examiner **cannot** use a "tack-on" approach to arbitrarily "pick and choose" elements from numerous references and combine these elements using hindsight. Any combination of elements in a manner that reconstructs the Appellant's invention only with the benefit of **hindsight** is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). *[emphasis added]*.

The use of numerous references in a single rejection is evidence of hindsight. There must be some reason, suggestion, or motivation found in the references whereby a person of ordinary skill in the field of the invention would make the combination. **That knowledge cannot come from the applicant's invention itself.** In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992) *[emphasis added]*. In addition, "[T]he genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some 'teaching, suggestion or reason' to combine cited references." Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ 2d 1378, 1383 (Fed. Cir. 1997). When the reference in question seems relatively similar "...**the opportunity to judge by hindsight is particularly tempting**. Consequently, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses numerous references. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). *[emphasis added]*.

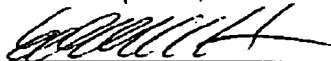
With regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on at least the same basis. (MPEP § 2143.03).

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In view of the arguments and amendments set forth above, the Applicants respectfully submit that the rejected claims are in immediate condition for allowance. The Examiner is therefore respectfully requested to withdraw the outstanding claim rejections and to pass this application to issue. Additionally, in an effort to expedite and further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (818) 885-1575. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
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